

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE  
TTAB

SEPT 22, 98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re International Data Group, Inc.

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Serial No. 74/695,276

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Mark B. Harrison of Spencer & Frank for applicant.

Jennifer M. B. Krisp, Trademark Examining Attorney, Law  
Office 107 (Thomas Lamone, Managing Attorney).

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Before Seeherman, Hairston and Walters, Administrative  
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

International Data Group, Inc. has filed a trademark  
application to register the mark WEB COMMERCE for  
"magazines, magazine supplements, catalogues, manuals,  
brochures, pamphlets, guides, newsletters, journals and  
books in the fields of computers, on-line services, high  
technology, communications and information services," in  
International Class 16, and "providing on-line magazines,

magazine supplements, catalogues, manuals, brochures, pamphlets, guides, newsletters, journals and books in the fields of computers, on-line services, high technology, communications and information services," in International Class 42."<sup>1</sup> The application includes a disclaimer of the term WEB apart from the mark as a whole.<sup>2</sup>

The Trademark Examining Attorney has finally refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its goods and services.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

The Examining Attorney contends that WEB COMMERCE refers to "the concept of carrying out commercial and business related activities on the World Wide Web"; that the term is "universally understood when used in the sense of a 'noun' to identify a collective set of activities centered on utilizing digital technology, specifically Internet technology, in order to promote goods and services and consummate monetary business transactions"; that WEB

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<sup>1</sup> Serial No. 74/695,276, filed June 29, 1995, based on an allegation of a bona fide intention to use the mark in commerce.

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<sup>2</sup> In its response of June 4, 1996, applicant concedes that "WEB is short for 'World Wide Web,'" which is part of the on-line global information network.

COMMERCE merely describes the subject matter of applicant's print and on-line publications; and that, while WEB COMMERCE "has several related connotations," each of these connotations is merely descriptive in connection with the identified goods and services. The Examining Attorney submitted numerous excerpts from the LEXIS/NEXIS database in support of her position.

Applicant contends that WEB COMMERCE is "merely suggestive of the wide range of topics covered by applicant's goods and services"; and that it is a "vague and ambiguous [term], with multiple definitions that have suggestive connotations with respect to the applicant's publications and on-line services." In this regard, applicant posits the following.

[P]rinted publications titled WEB COMMERCE could deal with 1) jobs or employment opportunities on the worldwide web; or 2) business establishments on the worldwide web; or 3) affairs or matters concerning the worldwide web of a very general nature; or 4) business dealings on the worldwide web; or 5) how to operate a business on the worldwide web; or 6) the volume or amount of trade on the worldwide web; or 7) hardware or software for use on the worldwide web. Or, using the examiner's definition, a topic of a particular article might even deal with "the commercial implications of businesses becoming on-line users of the worldwide web" or "the possibilities for commercial growth and development among all entities which utilize the worldwide web as a means of interactive communication and information dissemination."

Applicant contends that the evidence submitted by the Examining Attorney shows merely that the term WEB COMMERCE is used in multiple contexts with a variety of meanings, not that it has any special significance or meaning in the relevant industry.

The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

The evidence submitted by the Examining Attorney, several examples of which follow, indicates a consistent use of the term WEB COMMERCE to refer to the electronic offering and sale of goods and services via the World Wide Web.

"The technology will allow for universally secure data transfer - be it credit card transactions, corporate data transfers or Web commerce -- between different Web clients and Web servers, ..." [ *Electronic Marketplace Report*, April 18, 1995.]

"ATM Technology Secures Payments" - "... designed to be a full end-to-end Internet security system, ... WebSafe can support payment applications, Web commerce, certification authorities, privacy enhanced mail and electronic data interchange (EDI)." [ *Financial Services Report*, November 8, 1995.]

"Still, most industry experts don't expect any of these hurdles to permanently derail Web commerce. Indeed, signs of change are evident. More and more catalogers are going onto the Web." [ *Electronic Marketplace Report*, October 17, 1995.]

"... currency on the Web is still a dicey digital issue. In fact, security - or lack thereof - emerges as another barrier to Web commerce, ..." [ *Rochester Business Journal*, October 6, 1995.]

"... friction associated with trade mediated by phone, fax, and FedEx. Some of that friction, however, is being transferred to the IS department, which must make Web commerce work to the corporation's benefit." [ *Datamation*, June 15, 1995.]

"... and 14<sup>th</sup> largest [bank] in North America, is the second bank to use Open Market software to host Web commerce for its merchants. It joins

First Union Bank In Charlotte, N.C., ..."  
[*InformationWeek*, July 22, 1996.]

"Web Yellow Pages Let Your PC Do the Walking" -  
"... Big Yellow's Business Guide offers helpful  
information on developing a cost-effective online  
strategy and links to Web commerce sites." [*PC  
Magazine*, July, 1996.]

"Microsoft Gets Sought-after eShop" - "... with  
last week's acquisition of eShop Inc., which  
provides eShop Plaza, a virtual shopping mall,  
and other Web commerce technology." [*InfoWorld*,  
June 17, 1996.]

"For Burlington, like other businesses exploring  
Web commerce, bridging the knowledge and culture  
gap within the company can be more difficult than  
ringing up an online sale." [*LAN Times*, June 17,  
1996.]

"Web Database Server; Interactive Pages Created  
Easily with WebBase Pro" - "... the professional  
version is well-suited for developing some  
interesting forms of Web commerce and interactive  
server-to-server communications." [*InfoWorld*,  
June 10, 1996.]

"Prodigy [has] allowed customers to purchase a  
wide variety of goods online for years. To date,  
the biggest impediment to Web commerce has been  
the potential risk of sending your credit card  
number or other transaction data over an  
inherently insecure ..."

...

"Bill Gates gave a demonstration of a Web  
commerce application that Microsoft has developed  
with Wal-Mart. The application allows an online  
shopper to send criteria to a store, then receive  
..." [*PC Magazine*, May 28, 1996.]

There appears to be no question that there are numerous  
issues pertaining to doing "Web commerce," from the  
security of sales transactions to setting up a Web site for

doing business (which could include topics ranging from what software to use to the economics of such an endeavor). However, the breadth of the field described by the term WEB COMMERCE does not render this term with a specific connotation suggestive as opposed to merely descriptive. *See, In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd*. 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989).

In the present case, it is our view that, when applied to applicant's goods and services, the term WEB COMMERCE immediately describes, without conjecture or speculation, a significant feature or function of applicant's goods and services, namely, that applicant's print and on-line publications pertain to the full range of issues relevant to doing business, *i.e.*, selling goods and services, via the World Wide Web. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's services to readily perceive the merely descriptive significance of the term WEB COMMERCE as it pertains to applicant's goods and services.



Serial No. 74/695,276

Decision: The refusal under Section 2(e)(1) of the  
Act is affirmed.

E. J. Seeherman

P. T. Hairston

C. E. Walters  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board